

REMARKS

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

Claims 1-19 are pending in this application.

Claim 1 has been amended to replace formula (1) with formula (Z), which has variables X¹ to X⁸ as carbon atoms, and R¹², X³, X⁴ and R¹⁴ taken together to form a phenyl ring, and R¹⁵, X⁸, X⁷ and R¹³ taken together to form a phenyl ring. Support for formula (Z) can be found in compounds (A) to (K) on pages 53-58 of the specification.

Claim 1 has also been amended to recite “R⁴, R⁵, R⁶, R⁷, R⁸, R⁹, R¹⁰ and R¹¹”.

Claims 11 and 16 have been amended to recite “R²³, R²⁴ and R²⁵”.

Claims 18 and 19 have been amended to make minor editorial changes that are self-explanatory.

I. Claim Rejections Under 35 U.S.C. § 112

A. First Paragraph

The Examiner rejects claims 1-3 under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for all tricyclic and pentacyclic ring systems of formula (1). As applied to the amended claims, Applicants respectfully traverse the rejection.

According to MPEP 2164.01(b), “As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied.”

The Examiner acknowledges that the present specification teaches **11 examples** where X¹, X², X³, X⁴, X⁵, X⁶, X⁷ and X⁸ in formula (1) are all carbon atoms, and R¹² and R¹⁴, as well as R¹³ and R¹⁵, are taken together form a phenyl ring (see page 3, line 21 – page 4, line 1 of the Office Action). Moreover, the compounds of claim 1 have been limited to the pentacyclic ring system of formula (Z).

Applicants’ 11 working examples enable one of ordinary skill in the art to make and use the claimed compounds without undue experimentation. Thus, the enablement requirement is satisfied.

Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Second Paragraph

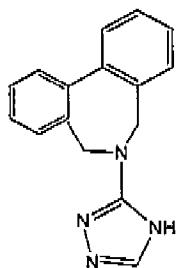
The Examiner rejects claims 1-3 under 35 U.S.C. 112, second paragraph, as being indefinite. As applied to the amended claims, Applicants respectfully traverse the rejection.

The Examiner asserts that the ranges recited in the claims of “R⁴ to R¹⁵”, “R¹ to R¹⁵” and “X¹ to X⁸” are indefinite. Claim 1 has been amended to recite “R⁴, R⁵, R⁶, R⁷, R⁸, R⁹, R¹⁰ and R¹¹”. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

II. Claim Rejection Under 35 U.S.C. § 102

The Examiner rejects claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Aboul-Enein et al. (Drug Design and Delivery). As applied to the amended claims, Applicants respectfully traverse the rejection.

The Examiner asserts that the reference teaches a compound of formula (1) where R¹ and R² are taken together to form a 3-(1,2,4-triazolyl) ring, as set forth in examples 10c of Table III of the reference, depicted below.



In claim 1 of the present application, R¹ and R² represent a hydrogen atom, a hydrocarbon group optionally having substituent(s), or a heterocyclic group optionally having substituent(s). **R¹ and R² do not form a 3-(1,2,4-triazolyl) ring.**

Therefore, the compound disclosed in the reference does not anticipate the compounds of claim 1.

Claims 2 and 3 depend directly or indirectly from claim 1, and thus also are not anticipated by the reference.

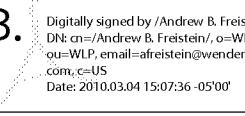
III. Conclusion

For these reasons, Applicants take the position that the presently claimed invention is clearly patentable over the applied reference.

Therefore, in view of the foregoing amendments and remarks, it is submitted that the rejections set forth by the Examiner have been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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